

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Van WALRAVEN

Application No.: 10/534,614

I. A. Filing Date: October 29, 2003

Filed: May 11, 2005

For: ...

Customer Service Window, Mail Stop Amendment

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building, 401 Dulany Street
Alexandria, Virginia 22314

Sir:

Transmitted herewith is a REPLY TO RESTRICTION REQUIREMENT in the above-identified application.

[] Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.
 No additional fee is required.
 The fee has been calculated as shown below:

| | (Col. 1) | (Col. 2) | (Col. 3) |
|---|---|-------------|---------------------------------------|
| | CLAIMS REMAINING AFTER AMENDMENT | | HIGHEST NO. PREVIOUSLY PAID FOR |
| TOTAL | * | MINUS ** 20 | 0 |
| INDEP. | * | MINUS *** 3 | 0 |
| FIRST PRESENTATION OF MULTIPLE DEP. CLAIM | | | |

| SMALL ENTITY | | OR | OTHER THAN SMALL ENTITY | |
|----------------------|-------------------|----|-------------------------|-------------------|
| RATE | ADDITIONAL FEE | | RATE | ADDITIONAL FEE |
| x 25 | \$ | | x 50 | \$ |
| x 100 | \$ | | x 200 | \$ |
| + 180 | \$ | | + 360 | \$ |
| ADDITIONAL FEE TOTAL | | | TOTAL | |

* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
 ** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
 *** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

[] It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

[] First - \$ 60.00
 [] Second - \$ 225.00
 [] Third - \$ 510.00
 [] Fourth - \$ 795.00

Month After Time Period Set

[] Less fees (\$_____) already paid for ____ month(s) extension of time on _____.

Other Than Small Entity

Response Filed Within

[] First - \$ 120.00
 [] Second - \$ 450.00
 [] Third - \$ 1020.00
 [] Fourth - \$ 1590.00

Month After Time Period Set

[] Please charge my Deposit Account No. 02-4035 in the amount of \$_____.

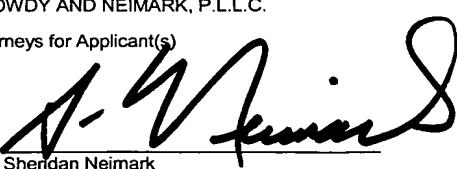
[] Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$_____.

[] A check in the amount of \$_____ is attached (check no.).

The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By: 
 Sheridan Neimark
 Registration No. 20,520

Facsimile: (202) 737-3528
 Telephone: (202) 628-5197



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: WALRAVEN=4

In re Application of:) Confirmation No.: 7451
Jan Van WALRAVEN)
I.A. Filing Date: 10/29/2003) Art Unit: 3723
371(c) Date: May 11, 2005)
U.S. Appln. No.: 10/534,614) Examiner: David B. Thomas
For: ASSEMBLY OF A NUT BODY IN)
A PORFILED-SECTION...) September 7, 2006

REPLY TO RESTRICTION REQUIREMENT

Customer Service Window, Mail Stop Amendment
Honorable Commissioner for Patents
U.S. Patent and Trademark Office
Randolph Building
401 Dulany Street
Alexandria, Virginia 22314

Sir:

Applicant is in receipt of the Office Action mailed August 11, 2006, entirely in the nature of a Restriction Requirement based on purported lack of unity of invention under PCT Rules 13.1 and 13.2. Applicant replies below.

First, however, it should be noted that applicant has claimed priority from two applications filed in the Netherlands in November and December 2002. Copies of the priority applications have been submitted To the PTO by the International Bureau of WIPO. **Accordingly, applicant**

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Amd. dated
Reply to Office Action of

**respectfully requests the PTO to acknowledgement receipt of
applicant's papers filed under Section 119.**

Restriction has been required among what the PTO deems to be four (4) patentably distinct inventions. As applicant must make an election even though the requirement is traversed, applicant hereby respectfully and provisionally elects Group I, presently claims 1-17, with traverse and without prejudice.

Applicant respectfully notes that the Group III claims 18 and 42, which relate to a method for mounting an elongate nut body in a profiled section element by means of an assembly tool, as well as claims 40 and 41 from Group IV, which relate to a package including a plurality of nut bodies and an assembly tool, should be considered as belonging to the same invention as claims 1-17. This is supported by the unity on invention ruling made during the International Phase by the International Searching Authority, where it was found and held that there were only two groups (rather than the four listed by the PTO). The first designated group was said to relate to an assembly tool for securing a system composed of an elongated profiled section element and a spring loaded nut and method of assembling, subject matter which the applicant would like to pursue at the present time. For sake of completeness, a copy of the International Search Report is attached.

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Applicant understands that the PTO is not bound to follow the International Searching Authority, but what the International Searching Authority found should not be ignored by the PTO, particularly taking into account the elements of comity and harmonization.

Applicant notes that the Office Action indicates different fields of search for the four groups, but this is a criterion for normal restriction practice, not unity of invention under PCT Rules 13.1 and 13.2. Applicant also notes that the Office Action states that Groups I-IV do not relate to a single general inventive concept under PCT Rule 13.1 because they lack the same or corresponding special technical features as required by PCT Rule 13.2, **but** there is no indication of why the PTO thinks that this is so. It is certainly contrary to what the International Searching Authority found, as pointed out above. Moreover, applicant has pointed out above why claims 1-17, 18 and 42, and 41 and 41 do relate to a singly general inventive concept because they have the same or corresponding special technical feature, and therefore these claims fall into a single group under PCT Rules 13.1 and 13.2.

Accordingly, applicant respectfully requests the examiner to regroup the claims into two (2) groups only, Group I including claims 1-18 and 40-42, for examination purposes.

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If the examiner were to so regroup the claims whereby applicant would then elect the new Group I, applicant would accept such a regrouping without traverse, thus waiving applicant's right to petition.

Applicant would like to mention one further point. Applicant has acknowledged above the separate classification, and pointed out that this is a point for regular restriction practice, but not unity of invention practice. Applicant would like to add that a complete search of claims 1-17 would also require a search into the location of claims 18 and 42, namely class 29, subclass 428, as well as the location of claims 40 and 41 in class 206. Once such a complete search has been conducted, it would then not be a "serious burden" to also examine claims 18 and 40-42. Thus, even if the PTO were to disagree with applicant's position as pointed out above relating to unity of invention, which is **applicant's main point**, the second paragraph of MPEP 803 would come into play, which **requires** an examination of those claims which are properly restricted out if it would not constitute a serious burden to do so. Applicant believes that there would be no serious burden in examining claims 18 and 40-42 along with claims 1-17.

Nevertheless, this issue should not be reached, as there is no lack of unity of invention between the presently

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designated Group I claims 1-17, and claims 18 and 40-42, for the reasons pointed out above.

Accordingly, applicant again respectfully requests withdrawal or at least re-grouping, and examination on the merits of claims 1-18 and 40-42.

Applicant now respectfully awaits the results of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By



Sheridan Neimark
Registration No. 20,520

SN:kg
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
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INTERNATIONAL SEARCH REPORT

Intern. Application No
PCT/NL 03/00736

A. CLASSIFICATION OF SUBJECT MATTER
IPC 7 F16B37/04 B25B13/02

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)
IPC 7 F16B B25B

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

EPO-Internal

C. DOCUMENTS CONSIDERED TO BE RELEVANT

| Category | Citation of document, with indication, where appropriate, of the relevant passages | Relevant to claim No. |
|----------|--|---------------------------------------|
| X | FR 2 515 753 A (ROSE ELEKTROTECH GMBH) 6 May 1983 (1983-05-06) | 1,2,4,6, 14,15, 17-20, 34-36 |
| A | page 5, line 28 - line 35; claims; figures | 3,5, 37-40 |
| X | WO 96 33349 A (OEGLAEND SYSTEM AS ;GYA ARNE (NO)) 24 October 1996 (1996-10-24) | 1-6,10, 11,17-19 |
| A | page 10, line 29 -page 11, line 26; claim 6; figures 8-11,13 | 21,37-40 |
| X | DE 199 28 144 A (ALTRATEC MONTAGESYSTEME) 21 December 2000 (2000-12-21) | 1,2,4,6, 17-19 |
| A | column 2, line 27 - line 30; figures | 20,26, 27,37-40 |
| | | --- |
| | | -/- |

Further documents are listed in the continuation of box C.

Patent family members are listed in annex.

* Special categories of cited documents :

- *A* document defining the general state of the art which is not considered to be of particular relevance
- *E* earlier document but published on or after the international filing date
- *L* document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- *O* document referring to an oral disclosure, use, exhibition or other means
- *P* document published prior to the international filing date but later than the priority date claimed

- *T* later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- *X* document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- *Y* document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.
- *&* document member of the same patent family

Date of the actual completion of the international search

10 February 2004

Date of mailing of the international search report

17/02/2004

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2
NL - 2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Majerus, H

INTERNATIONAL SEARCH REPORT

Int'l application No.
PCT/NL 03/00736

Box I Observations where certain claims were found unsearchable (Continuation of item 1 of first sheet)

This International Search Report has not been established in respect of certain claims under Article 17(2)(a) for the following reasons:

1. Claims Nos.: because they relate to subject matter not required to be searched by this Authority, namely:

2. Claims Nos.: because they relate to parts of the International Application that do not comply with the prescribed requirements to such an extent that no meaningful International Search can be carried out, specifically:

3. Claims Nos.: because they are dependent claims and are not drafted in accordance with the second and third sentences of Rule 6.4(a).

Box II Observations where unity of invention is lacking (Continuation of item 2 of first sheet)

This International Searching Authority found multiple Inventions in this international application, as follows:

see additional sheet

1. As all required additional search fees were timely paid by the applicant, this International Search Report covers all searchable claims.

2. As all searchable claims could be searched without effort justifying an additional fee, this Authority did not invite payment of any additional fee.

3. As only some of the required additional search fees were timely paid by the applicant, this International Search Report covers only those claims for which fees were paid, specifically claims Nos.:

4. No required additional search fees were timely paid by the applicant. Consequently, this International Search Report is restricted to the invention first mentioned in the claims; it is covered by claims Nos.:

Remark on Protest

The additional search fees were accompanied by the applicant's protest.
 No protest accompanied the payment of additional search fees.

INTERNATIONAL SEARCH REPORT

 Internal Application No
 PCT/NL 03/00736

| Patent document cited in search report | | Publication date | | Patent family member(s) | | Publication date |
|--|----|------------------|--|---|--|--|
| FR 2515753 | A | 06-05-1983 | BR CH FR | 8206384 A 657428 A5 2515753 A1 | | 27-09-1983 29-08-1986 06-05-1983 |
| WO 9633349 | A | 24-10-1996 | NO AU WO | 951516 A 5517596 A 9633349 A1 | | 22-10-1996 07-11-1996 24-10-1996 |
| DE 19928144 | A | 21-12-2000 | DE | 19928144 A1 | | 21-12-2000 |
| FR 96603 | E | 20-07-1973 | FR | 1413191 A | | 08-10-1965 |
| US 2383573 | A | 28-08-1945 | NONE | | | |
| US 2003049094 | A1 | 13-03-2003 | NONE | | | |
| EP 0149128 | A | 24-07-1985 | US AU AU CA DE EP IN ZA | 4575295 A 570088 B2 3649484 A 1245886 A1 3462940 D1 0149128 A1 163545 A1 8409815 A | | 11-03-1986 03-03-1988 18-07-1985 06-12-1988 07-05-1987 24-07-1985 08-10-1988 31-07-1985 |
| EP 0516321 | A | 02-12-1992 | EP | 0516321 A1 | | 02-12-1992 |
| GB 842334 | A | 27-07-1960 | NONE | | | |